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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,839	10/11/2001	Andrew Egendorf	7178-207	4483

7590

04/24/2002

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EXAMINER

FELTEN, DANIEL S

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/975,839

Applicant(s)

Egendorf

Examiner

D. FELTEN
~~First Last~~

Art Unit

2164
~~1234~~

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for ReplyA SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 11, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-45 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(a). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-818) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(a). _____ 20) ☐ Other: _____

Serial Number: 09/975,839

Applicant(s): Egendorf (705/40)

Page 2

Art Unit: 2164

Representative: Schaefer (26,802)

DETAILED ACTION

1
2 1. Receipt of the Preliminary Amendment filed April 9, 2002 canceling claims 1-30 and
3 adding claims 31-45 is acknowledged. Claims 31-45 are now pending in the application and are
4 presented to examined upon their merits.

5
6 2. Acknowledgment is made that the current application Serial No. 09/975,839 filed
7 October 11, 2001 is a CONTINUATION of application Serial No. 09/568,925 filed May 11,
8 2000 and now pending, which is a CONTINUATION of application Serial No. 09/057,230
9 filed April 8, 1998 now U.S. Patent No. 6,188,994 which is a CONTINUATION of
10 application Serial No. 08/499,535 filed July 7, 1995 now U.S. Patent No. 5,794,221.

11
12
13 **Double Patenting**

14
15 3. The nonstatutory double patenting rejection is based on a judicially created doctrine
16 grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
17 improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
18 harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
19 Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
20 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
21 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

22 A timely filed terminal disclaimer in compliance with 37 CFR 1.321~~6~~ may be used to
23 overcome an actual or provisional rejection based on a nonstatutory double patenting ground

Serial Number: 09/975,839

Applicant(s): Egendorf (705/40)

Page 3

Art Unit: 2164

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 31-45 are rejected under the judicially created doctrine of double patenting over claims of U. S. Patent No. 5,794,221 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: An Internet Billing Method establishing a billing agreement with at least one customer...establishing a remitting agreement with at least one vendor...billing/charging a transaction amount to at least one customer...remitting an amount/portion to the selling vendor.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

Serial Number: 09/975,839

Applicant(s): Egendorf (705/40)

Page 4

Art Unit: 2164

Representative: Schaefer (26,802)

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday. Any inquiry of a general nature relating to the status of this application or its proceedings should be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor **Vincent Millin** whose telephone number is (703) 308-1065.

6. Response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

for formal communications intended for entry, or (703) 305-0040, for informal or draft communications, please label "Proposed" or "Draft".

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.felten@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

Serial Number: 09/975,839

Applicant(s): Egendorf (709/40)

Page 5

Art Unit: 2164

Representative: Schaefer (26,802)

1 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and
2 Trademark on February 25, 1997 at 1 195 OG 89.

3
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5 DSF

6 April 18, 2002

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